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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,846	11/25/2003	Joop Peterse	A3279	6954

25453 7590 12/08/2004

PATENT DOCUMENTATION CENTER
XEROX CORPORATION
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EXAMINER

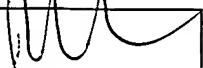
SIPOS, JOHN

ART UNIT PAPER NUMBER

3721

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/721,846	Applicant(s) PETERSE ET AL. 	
	Examiner John Sipos	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ELECTION

Claims 14-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/4/2004.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure does not provide support for the amended claims that the fingers are comprised of essentially "inelastic" material. Applicants attempt to provide support for this language on page 8 of the Amendment by referring to Figure 1, by the comparison to the Polyair Airspace Pillow Packaging System of paragraph 0003 of the specification and by the list of material that can be used for the fingers set forth in paragraph 0013 of the specification. None of these references provide positive support for the inelastic material used for the fingers of the air bladder. "Elastic" is defined The Random House College Dictionary as a material that is capable of returning to its original length, shape etc. "Inelastic"

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therefore means that the material is not capable of returning to its original length, shape etc. Figure `1 of the instant application provides no support for either the use of elastic or inelastic material for the fingers. The comparison paragraph 0003 again makes no mention of the finger material. The list of materials in paragraph 0013 is nothing more than a list of materials that may be used for the fingers. The complete sentence states that "Polyethylene, polypropylene, and PVC are among the large number of plastic resins suitable for use as the film material comprising air bladder 10." This sentence basically states that the three materials may be used but are not a complete list of materials that can be used. This is further emphasized in the specification by the next sentence that "Virtually any flexible plastic film material that is airtight can be used, especially if it is thermoplastic in order to make heat-sealing of seams possible.". No mention of the elastic or inelastic nature of the material is set forth.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 1,6,8,11 and 26 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Harreld (4,486,975) (if the new matter is cancelled from the claims). The patent to Harreld shows an air bladder comprising of a center body (see numeral 11), a plurality of essentially tubular fingers 12,13 connected to the center body and valve means 24 to inflate the center body and fingers. The position of the air bladder in a package is merely a recitation of intended use which use the bladder of Harreld is capable of performing. Note

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that the claim is merely directed to "An air bladder". The structure of the item and box are not part of the claim or the structure of the air bladder.

Claims 1,2,4,6,8,9,11 and 26 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Lemelson (4,179,832) (if the new matter is cancelled from the claims). The patent to Lemelson shows an air bladder comprising of a round center body 43, a plurality of essentially tubular fingers 38-42 connected to the center body and a plurality of valve means on the fingers to inflate the center body and fingers (see column 5, line 19 et seq.). The position of the air bladder in a package is merely a recitation of intended use which use the bladder of Lemelson is capable of performing. Note that the claim is merely directed to "An air bladder". The structure of the item and box are not part of the claim or the structure of the air bladder.

Claims 1-4,6,7,11,13 and 26 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Aninger (3,398,501) (if the new matter is cancelled from the claims). The patent to Aninger shows an air bladder comprising of a round center body 12, a plurality of essentially tubular fingers 14 connected to the center body and valve means 18 on one finger to inflate the center body and fingers. The bladder is placed around an article so that the fingers are positioned between the article and the sides of the box containing the article. Regarding claim 13, the "seam" is read on the base lines of Aninger shown at the bottom of each finger where it connect to the center portion.

Claims 2,3,7,9,10,12 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975) (if the new matter is cancelled from the claims). The use of valves on the fingers (claim 2), the use of filling tubes (claim 3), the number of fingers (claim 7), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits. Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

Claims 3,5,7,10,12,13 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975) (if the new matter is cancelled from the claims). The use of filling tubes (claim 3), the shape of the center body (claim 5), the number of fingers (claim 7), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits. Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

Claims 5,8-10,12 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Aninger (3,398,501) (if the new matter is

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cancelled from the claims). The shape of the center body (claim 5), the number of fingers (claim 8), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) are well known in the art and their use would have been obvious for their known benefits.

Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

Claims 1-13,26 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975) (if the new matter is not cancelled from the claims). The use of valves on the fingers (claim 2), the use of filling tubes (claim 3), the number of fingers (claim 7), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits. The use of either inelastic or elastic materials for the packaging material would have been obvious to one of ordinary skill in the art since it does not affect the process or structure of the package. Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

Claims 1-13,26 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975) (if the new matter is not

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cancelled from the claims). The use of filling tubes (claim 3), the shape of the center body (claim 5), the number of fingers (claim 7), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits. The use of either inelastic or elastic materials for the packaging material would have been obvious to one of ordinary skill in the art since it does not affect the process or structure of the package. Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

Claims 1-13,26 and 27 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Aninger (3,398,501) (if the new matter is not cancelled from the claims). The shape of the center body (claim 5), the number of fingers (claim 8), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) are well known in the art and their use would have been obvious for their known benefits. The use of either inelastic or elastic materials for the packaging material would have been obvious to one of ordinary skill in the art since it does not affect the process or structure of the package. Regarding claim 27, it would have been obvious to one of ordinary skill in the art to eliminate the use of apertures and their interlocking function since it has been held that the elimination of a means and its function is an obvious modification of a known article.

RESPONSE TO APPLICANT'S ARGUMENTS

Applicants' arguments have been considered but are not persuasive. The arguments that Harreld and Lemelson are non-analogous art is not convincing since the claims are directed to an inflatable bladder with the intended use being in the packaging art. The combination of the package and the bladder is not being claimed. These two references may be directed to articles that are not used in packaging but they do meet the structural limitations of the claims and they can be used in packaging if desired. The intended use set forth in the preamble and the narrative portion of the claim are given weight but since the packaged article is not part of the claims and the applied references are fully capable to perform the claimed function the claims read on the references.

Regarding the Harreld reference, the "inflatable center body" of the instant claims is read on the inflatable center body 11 that is in the center of the bladder and to which the inflatable fingers 12,13 are attached. Furthermore, the claimed function of the fingers is nothing more than an intended use that may or may not be performed with the claimed bladder. Since the bladder of Harreld is fully capable of being used to protect a package the claimed structure is read on the structure shown by Harreld.

Applicants' arguments regarding the Lemelson reference are directed to the extra elements that Lemelson discloses (and claims) that have no bearing on the instant claimed invention. The extra disclosure does not prevent the reading

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of the instant claims on the reference. The claimed structure is shown by Lemelson and it is fully capable to be used to protect a package.

Similarly, the arguments relating to Aninger that the fingers lock together are extra disclosure of Aninger. The instant claims still read on the reference. Applicant's arguments are directed to the use of the claimed invention and the use of the Aninger invention and not to the structure that is being claimed. The Examiner also does not agree with the statement made at the end of the last full paragraph on page 8 of the amendment that Aninger teaches an elastic material. The quoted phrase from Aninger is merely what happens when inflation of the fingers takes place. However, this does not reflect on the kind of material being used. This inflation can take place with either material that return to its original size and shape as well as to materials that do not return to their original size and shape. This is the same inflation and operation as set forth in applicant's disclosure without any specifics to the elastic nature of the material.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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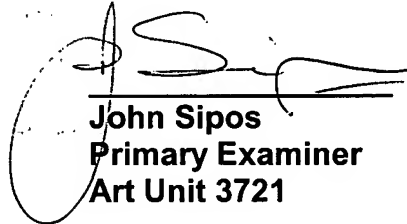
the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9306**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.



John Sipos
Primary Examiner
Art Unit 3721

js